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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/764,931 | 01/26/2004 | Peter Robert Foley | CM-2491D | 9645 |

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| EXAMINER | |
|---|---|
| DELCOTTO, GREGORY R | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 1751 | |

DATE MAILED: 11/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/764,931 | FOLEY ET AL. | |
| | Examiner | Art Unit | |
| | Gregory R. Del Cotto | 1751 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *RCE filed 10/30/06*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1,2 and 6* is/are pending in the application.

4a) Of the above claim(s) *1* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *2 and 6* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☒ Certified copies of the priority documents have been received in Application No. 09/909,403.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

## DETAILED ACTION

1. Claims 1, 2, and 6 are pending. Claims 3-5 and 7-12 have been canceled. Applicant's arguments and amendments filed 10/30/06 have been entered.

Claim 1 is withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 1/5/05.

### *Continued Examination Under 37 CFR 1.114*

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/30/06 has been entered.

### Objections/Rejections Withdrawn

The following objections/rejections as set forth in the Office action mailed 7/28/06 have been withdrawn:

The rejection of claims 2 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kacher (US 5,891,836), Hees et al (US 6,090,764), or JP 2000-44990, all in view of Uchiyama et al (US 2002/0010106) has been withdrawn.

### *Priority*

Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. 09/909403, filed on 7/19/2001.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a)

Claims 2 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Feng (US 5,929,007) or JP-141800, both in view of Uchiyama et al (US 2002/0010106).

'800 teaches a liquid detergent composition containing 0.1 to 10% by weight of a swellable clay mineral, 0.1 to 30% of a solvent, 1 to 20% of a surfactant and 0.5 to 30%

of an alkali agent. Suitable solvents include diethylene glycol monobutyl ether, etc. See page 4, lines 10-50. Note that, amine oxide surfactants and monoethanolamine may also be used in the compositions. See page 9, lines 1-30. Suitable additional ingredients include fragrances, dyes, etc. See page 6, lines 1-15. The product of the invention my be used as-is, and an aerosol or spray-type product is also appropriate from the standpoint of ease of use. See page 6, lines 1-10. Note that, the Examiner asserts that the broad teachings of '800 would suggest a spray of the cleaning product having the same droplet size as recited by the instant claims. '800 teaches that the compositions may be used to clean organic materials adhered to household stoves, ovens used in cooking, vents, plywood, glass, refrigerators, and other kitchen items. See page 3, lines 1-10. The Examiner asserts that other kitchen items as taught by '800 would encompass tableware or cookware having oil or grease adhered to the surface.

Feng teaches alkaline aqueous hard surface cleaning compositions which exhibit good cleaning efficacy against hardened dried or baked on greasy soil deposits. The compositions comprise 0.01 to 0.85% by weight of amine oxide, 0 to 1.5% by weight of chelating agent, 0.01% to 2.5% by weight of caustic, 3% to 9% by weight of glycol ether solvent system comprising one glycol ether or glycol ether acetate solvent having a solubility in water of not more than 20% by weight water and a second glycol ether or glycol ether acetate having a solubility of approximately 100% by weight wherein the ratio of the former to the latter is from 0.5:1 to 1.5:1, 0 to 5% by weight of a water-soluble amine containing organic compound, 0 to 2.5% by weight of a soil anti-

redeposition agent, and 0 to 2.5% of optional constituents. See Abstract. The caustic agent is present in the compositions to ensure that the overall pH of the compositions is at least 11.5 or greater. Suitable solvents which exhibit a solubility in water of approximately 100% by weight include diethylene glycol n-butyl ether. See column 4, lines 20-65. The compositions preferably include a soil antiredeposition agents which may be synthetic hectorite, colloidal silica, etc. See column 5, lines 50-69. Another desirable additive is a thickening agent such as those based on alginates and gums including xanthan gum. See column 6, lines 5-40. Additionally, the compositions may contain optional constituents such as buffers, pH buffering agents, fragrances, fragrance carriers, and adjuvants which increase their miscibility. See column 6, lines 30-40. Also, these compositions may desirably be provided as a ready to use product in a manually operated spray dispensing container. See column 8, lines 1-35. Note that, the Examiner asserts that the broad teachings of Feng would suggest a spray of the cleaning product having the same droplet size as recited by the instant claims.

Specifically, Feng teaches 2.0% amine oxide, 0.5% EDTA salt, 0.8% NaOH, 3.0% monoethanolamine, 3.0% glycol ether, low water soluble, 3.7% glycol ether, high water soluble, the balance water. See column 9, lines 35-50. The low water soluble glycol ether is propylene glycol n-butyl, the high water soluble glycol ether is dipropylene glycol methyl ether, etc.

Feng or '800 do not teach the use of cyclodextrin or a method of removing solids from tableware by spraying using a composition containing an organic solvent

system,organoamine, cyclodextrin, and the other requisite components of the composition in the specific proportions as recited by the instant claims.

Uchiyama et al teach a stable composition for removing unwanted molecules form a surface comprising cyclodextrin. The compositions are suitable for capturing unwanted molecules from inanimate surfaces including dishes. See Abstract. When the surfaces are treated with the compositions, the functionally-available cyclodextrin complexes with the unwanted molecules, thereby effectively removing and/or reducing the presence of the unwanted molecules on the treated surfaces. See para. 15. The compositions can be either emulsions/dispersions or clear, single-phase solutions. See para. 12. Additionally, the compositions may contain a carrier such as alcohol. See para 137.

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to use cyclodextrin in the composition taught by Feng or '800, with a reasonable expectation of success, because Uchiyama et al teach the use of cyclodextrin in compositions for cleaning dishes effectively removes and/or reduces the presence of the unwanted molecules on the treated surfaces.

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to remove soils from tableware by spraying using a composition containing an organic solvent system, organoamine, cyclodextrin, and the other requisite components of the composition in the specific proportions as recited by the instant claims, with a reasonable expectation of success, because the broad teachings of Feng or '800 in combination with Uchiyama et al suggest removing soils from

tableware by spraying using a composition containing an organic solvent system, organoamine, cyclodextrin, and the other requisite components of the composition in the specific proportions as recited by the instant claims.

Note that, the Examiner asserts that the teachings of Feng or '800, both in combination with Uchiyama et al, would suggest compositions having the same liquid surface tension as recited by the instant claims because Feng or '800, both in combination with Uchiyama et al, suggest compositions containing the same components in the same amounts as recited by the instant claims.

***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 2 and 6 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 36-40 of

copending Application No. 09/909233 in view of Uchiyama et al (US 2002/0010106) or claims 30-35 of 09/909288 in view of Uchiyama et al (US 2002/0010106). Note that, for purposes of double-patenting, claims 30-32 of 09/909288 which are dependent upon canceled claim 1, have been interpreted to be dependent upon claim 57.

Claims 36-40 of 09/909233 or claims 30-35 of 09/909288 encompass all the material limitations of the instant claims except for the inclusion of a cyclodextrin.

Uchiyama et al are relied upon as set forth above.

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to use cyclodextrin in the composition used in the method recited by claims 36-40 of 09/909233 or claims 30-35 of 09/909288, with a reasonable expectation of success, because Uchiyama et al teach the use of cyclodextrin in compositions for cleaning dishes effectively removes and/or reduces the presence of the unwanted molecules on the treated surfaces.

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to remove soils from tableware using a composition containing an organic solvent comprising an organoamine, cyclodextrin, and the other requisite components of the composition in the specific proportions as recited by the instant claims, with a reasonable expectation of success, because claims 36-40 of 09/909233 or claims 30-35 of 09/909288 in combination with Uchiyama et al suggest removing soils from tableware using a composition containing an organic solvent comprising an organoamine, cyclodextrin, and the other requisite components of the composition in the specific proportions as recited by the instant claims.

This is a provisional obviousness-type double patenting rejection.

***Response to Arguments***

Note that, due to Applicant's amendments, a new ground of rejection has been made as set forth above. However, the Examiner will respond to Applicant's arguments with respect to the use of Uchiyama et al as a secondary reference as set forth below.

With respect to Uchiyama et al, Applicant states that while Uchiyama et al teach the use of cyclodextrin for capturing unwanted molecules from inanimate surfaces including dishes, the claimed method of use does not utilize cyclodextrin to capture unwanted molecules from inanimate surfaces but is used in order to help control solvent malodor. In response, note that, the reason or motivation to modify the reference may often suggest what the inventor has done, but for a different purpose or to solve a different problem. It is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by applicant. Note that, while there must be motivation to make the claimed invention, there is no requirement that the prior art provide the same reason as the applicant to make the claimed invention. In re Linter, 458 F.2d 1013, 173 USPQ 560 (CCPA 1972). See MPEP 2144.

The Examiner maintains that Uchiyama et al is a secondary reference relied upon for its teaching of cyclodextrin. As stated previously, the Examiner maintains that one of ordinary skill in the art clearly would have been motivated to use cyclodextrin in the dishwashing cleaning compositions taught by Feng or '800 with a reasonable expectation of success, because Uchiyama et al teaches that the use of cyclodextrin in dishwashing compositions (See para. 2. of Uchiyama et al) effectively removes and/or

reduces the presence of the unwanted molecules on the treated surfaces. Additionally, while Uchiyama et al does state that cyclodextrin does not complex effectively with some very low molecular weight organic amines and acids when they are present at low levels on wet fabrics, the Examiner has relied upon Uchiyama et al for its teaching of cyclodextrins in dishwashing compositions and asserts that cyclodextrins present in dishwashing compositons containing amine solvents would function to remove or reduce unwanted molecule on the surface(s) of the tableware and that these amine solvents would be different from any amine molecules present on wet fabrics.

In other words, the Examiner maintains the fact that Uchiyama et al does state that cyclodextrin does not complex effectively with some very low molecular weight organic amines and acids when they are present at low levels on wet fabrics would not lead one of ordinary skill in the art away from using the cyclodextrin in amine solvent containing dishwashing liquids to remove unwanted molecules on the surface of tableware or cookware. Thus, the Examiner maintains that Feng or '800, both in combination with Uchiyama et al is sufficient to suggest the claimed invention. Additionally, with respect to the provisional obviousness-type double patenting rejection, the Examiner maintains that claims 36-40 of copending Application No. 09/909233 in view of Uchiyama et al (US 2002/0010106) or claims 30-35 of 09/909288 in view of Uchiyama et al (US 2002/0010106) is sufficient to suggest the claimed invention.

***Conclusion***

2. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Remaining references cited but not relied upon are considered to be cumulative to or less pertinent than those relied upon or discussed above.

Applicant is reminded that any evidence to be presented in accordance with 37 CFR 1.131 or 1.132 should be submitted before final rejection in order to be considered timely.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory R. Del Cotto whose telephone number is (571) 272-1312. The examiner can normally be reached on Mon. thru Fri. from 8:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Douglas McGinty can be reached on (571) 272-1029. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Gregory R. Del Cotto
Primary Examiner
Art Unit 1751

GRD
November 17, 2006